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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,699	08/24/2001	Toshiya Uemura	P 282892	9658

7590 05/18/2004
McGinn & Gibb PLLC
8321 Old Courthouse Road
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T36-135964M/KOH
EXAMINER

KORNAKOV, MICHAEL

ART UNIT	PAPER NUMBER
1746	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,699

Applicant(s)

UEMURA ET AL.

Examiner

Michael Kornakov

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

20040512

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The replies filed on 03/02/2004 and 10/30/2003 is not fully responsive to the prior Office Action because of the following omissions (or matters):

As amended on 10/30/2003 and currently argued by Applicants the claim 1 and dependent claims 2-7, 11-20, as well as another newly presented group of claims 8-10 have been directed to an invention different from initially presented one. This initial invention has been acted upon by the Examiner, and Applicants received first Office Action on the merits. If three sets of claims i.e.

- a) initially presented
- b) currently amended claims 1-7, 11-20
- b) claims 8-10 as currently amended

had been presented before the first Office Action on the merits, these claims would have been subjected to a restriction requirement on the basis of combination/subcombination relationship, wherein the combination as instantly presented does not require the particularities of subcombination for patentability, simply because the subcombination is neither novel, nor non-obvious (as shown in the first Office action on the merits) and the subcombination, as was initially presented, has the utility by itself as a separate and independent cleaning process. Claims 8-10 as currently amended present a process completely different in scope compare to the initially claimed one, and if initially presented would have been subjected to a restriction requirement on the same basis, as discussed above.

Without addressing the issue of "... Examiner's bizarre allegations..." as stated by Applicants in their response, Applicants are advised that they are better served if only the merits of the Office Action are discussed.

With regard to Applicants' citations from 37 CFR 1.111 (b) and 37 CFR 1.111 (c) it is noted that these passages are not relevant to the present situation.

Applicants cited only a part of 37CFR 1.111(b), however the rest of 37CFR 1.111(b):

"If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to

advance the application or the reexamination proceeding to final action" (emphasis added-M.K) . In the instant case the claims as presented after the first office action are directed to a patentably distinct invention, as explained above.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "bona fide attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without

authority to postpone decision as to abandonment. Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c). 37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR 1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment (see MPEP 714.03).

The above-mentioned reply is once again considered to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED

UNDER 37 CFR 1.136(a).

M. KORNAROV

AU 1746

05/12/2004